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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/694,789	10/24/2000	Charles E. Farley	05242.87031	8595

7590

06/05/2002

Banner & Witcoff, Ltd.
1001 G Street, N.W.
Washington, DC 20001-4597

EXAMINER

FORTUNA, JOSE A

ART UNIT	PAPER NUMBER
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1731

10

DATE MAILED: 06/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

MF=10

Office Action Summary

Application No.

09/694,789

Applicant(s)

FARLEY ET AL.

Examiner

José A Fortuna

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 9 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3,6. 6) ☐ Other: _____

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DETAILED ACTION

Election/Restriction

1. Applicant's election with traverse of group I in Paper No. 9 is acknowledged. The traversal is on the ground(s) that the examples in the M.P.E.P., that unrelated inventions are not capable of use together. This is not found persuasive because the method of making a composition, i.e., method of emulsifying, cannot be and it is not disclosed to be capable of being used together with the paper produced with the composition. The composition per se is capable of being used together in the paper, but this has not being claimed, and even if the composition is claimed then a restriction is also possible and proper, because the composition can be used in a materially different process, such as in the textile or food industries. Note that the restriction requirements are met, i.e., they are not capable of being used together, see above and they have different modes of operation, functions and effects, see previous action

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 U.S.C. § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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3. Claims 1, 4-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamada et al., JP 09111692 A, (Derwent Abstract and Japanese Patent Office computer translation has been used as the translation).

Yamada et al. teach a size emulsion comprising a reactive size, alkenyl succinic anhydride, ASA, emulsified with a starch grafted acrylamide co-polymer, see abstract and pages 1-2 of the translation. Yamada et al. teach in page 2, [0014], that the proportion of starch to acrylamide monomers is between 10-95% of starch and 5-90% by weight of the acrylamide monomer, which falls within the claimed range.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 1-2 and 4-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Aizono et al., JP 2000265389 A.

Aizono et al. teach a size emulsion comprising a reactive size, alkenyl succinic anhydride, ASA, emulsified with a starch grafted acrylamide co-polymer, see abstract and sections [0016]-[0027] of the translation. Aizono et al. teach in sections [0017]-[0021], that the proportion of starch to acrylamide monomers is between 5-85% of starch and 15-95% by weight of the acrylamide monomer, which falls within the claimed range. Aizono et al. also teach, see section [0023], the use of a surfactant to help in the emulsification of the mixture.

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Claim Rejections - 35 U.S.C. § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Column.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Aizono et al.

Aizono et al. teach the use of surfactants to help in the emulsification of the mixture of ASA and starch grafted acrylamide, but they are silent with respect to the use of sodium dioctyl sulfosuccinate. However, the surfactants taught by Aizono et al. are equivalent to the claimed one and it has been held that “[W]here two equivalents are interchangeable for their desired function, substitution would have been obvious and thus, express suggestion of desirability of the substitution of one for the other is unnecessary.” *In re Fout* 675 F. 2d 297, 213 USPQ 532 (CCPA 1982); *In re Siebentritt*, 372 F.2d 566, 152 USPQ 618 (CCPA 1967). Thus the use of equivalents surfactants would have been obvious to one of ordinary skill in the art absent a showing of unexpected results.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure in the art of “Emulsifying Alkenyl Succinic Anhydride.”.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to José Fortuna, whose telephone number is (703)305-7498. The examiner can normally be reached on Monday-Friday from 9:30 A.M. to 5:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin, can be reached on (703)308-1164. The fax number for this group is (703)305-7115.

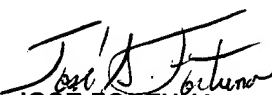
Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-0661.

When filing a FAX in group 1730, please indicate in the Header (upper right) “Official” for papers that are to be entered into the file, and “Unofficial” for draft documents and other

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communication with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

José A. Fortuna
May 28, 2002


JOSE FORTUNA
PRIMARY EXAMINER
ART UNIT 1731